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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/285,531	04/02/1999	YUTI CHERNAJOVSKY	KIR95-01A	3818

7590 08/11/2005

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NEW YORK, NY 10036

EXAMINER
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O HARA, EILEEN B

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/285,531

Applicant(s)

CHERNAJOVSKY ET AL.

Examiner

Eileen O'Hara

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 14,28-30 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14,28-30,32-34 and 37 is/are allowed.
- 6) ☒ Claim(s) 35 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 14, 28-30 and 32-37 are pending in the instant application. Claims 32-34 have been amended as requested by Applicant in the Paper filed July 21, 2005.

### ***Withdrawn Objections and Rejections***

2. Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 35 and 36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods of treatment of and autoimmune disease, an inflammatory bowel disease, rheumatoid arthritis, septic shock, cerebral malaria, multiple sclerosis and endotoxemic response, does not reasonably provide enablement for bacterial or viral infections, parasitic infections, a malignancy, a neurodegenerative disease, allograft rejection, host versus graft disease, and neoplastic pathology. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification teaches that the fusion protein of SEQ ID NO: 2 is an effective TNF binding protein and can protect cells in vitro from the cytotoxic effects of TNF (Example 3), and that TNF is a key mediator in a number of

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autoimmune and inflammatory diseases such as rheumatoid arthritis, septic shock, cerebral malaria and multiple sclerosis (reviewed in Tracy, K.J. and Cerami, A., *Ann. Rev. Cell. Biol.*, 9:317 (1993) (page 1 of specification). TNF inhibiting compounds are therefore useful in treatment of a number of such disorders or diseases. The specification on page 9 also teaches that the TNF inhibitor of the instant invention can be used to treat allograft rejection, graft vs. host disease and neoplastic pathology (e.g., in cachexis accompanying some malignancies). However, the specification has not provided any support for treatment of bacterial or viral infections, parasitic infections, a malignancy, a neurodegenerative disease, allograft rejection, host versus graft disease, and neoplastic pathology, and a search of the art also does not support treatment of these diseases or disorders with a TNF inhibitor. There are many factors considered when determining if the disclosure satisfies the enablement requirement and whether any necessary experimentation is undue. These factors include, but are not limited to: 1) nature of the invention, 2) state of the prior art, 3) relative skill of those in the art, 4) level of predictability in the art, 5) existence of working examples, 6) breadth of claims, 7) amount of direction or guidance by the inventor, and 8) quantity of experimentation needed to make or use the invention. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (FED. Cir. 1988).

It is acknowledged that the level of skill in the art is high. However, due to the lack of guidance in the specification and the prior art as to the involvement of TNF, the complexity of the diseases and disorders and treatment methods, the lack of working examples of methods of treatment, it is not predictable that these diseases or disorders could be effectively treated with the protein of SEQ ID NO: 2.

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***Conclusion***

4.1 Claims 14, 28-30, 32-34 and 37 are allowed.

4.2 Claims 35 and 36 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (571) 272-0878. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached at (571) 272-0829.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Eileen B. O'Hara, Ph.D.

Patent Examiner



**EILEEN B. O'HARA  
PATENT EXAMINER**